

REMARKS

In the Final Office Action mailed December 2, 2010 (the "Office Action"),¹ the Examiner took the following actions:

- (i) rejected claims 1-8, 10, 12, 13, 17-30, 35, 39-45, 47, and 49-55 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,839,737 to Friskel et al. ("*Friskel*") in view of U.S. Patent Application Publication No. 2003/0078981 to Harms et al. ("*Harms*");
- (ii) rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Friskel* in view of *Harms* and further in view of U.S. Patent Application Publication No. 2005/0086305 to Koch et al. ("*Koch*"); and
- (iii) rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over *Friskel* in view of *Harms* and further in view of U.S. Patent Application Publication No. 2003/0212745 to Caughey et al. ("*Caughey*").

Claims 1-8, 10-14, 17-30, 35, 39-45, 47, and 49-55 are pending in this application, including independent claims 1, 23, 45, 50, and 53.

Applicant respectfully traverse the rejections and submits that the pending claims are allowable over the prior art of record for at least the following reasons.

I. Rejection under 35 U.S.C. § 103 based on *Friskel* and *Harms*

Applicant respectfully traverses the rejection of claims 1-8, 10, 12, 13, 17-30, 35, 39-45, 47, and 49-55 under 35 U.S.C. § 103(a) as being unpatentable over *Friskel* in view *Harms*. A *prima facie* case of obviousness has not been established, at least because there are significant differences between the cited art and Applicant's claims.

¹ The final Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

For example, independent claim 1 recites a combination of elements including, among other things,

determining, at the one or more computers, that a person is known to the user based, at least in part, on one or more actions performed by the user on one or more messages received by the user from the person, the actions including one or more of (1) saving the one or more messages from the person; (2) printing the one or more messages from the person; (3) moving the one or more messages from the person from an inbox to a folder; and (4) leaving the one or more messages from the person open for a predetermined period of time.

The cited art, alone or in any proper combination, fails to disclose or suggest at least the aforementioned subject matter of claim 1.

The Office Action, on pages 4 and 5, concedes that

Friskel et al. fails to teach determining that a person is known to the user based, at least in part, on one or more actions performed by the user on one or more messages received by the user from the person, the actions including one or more of (1) saving a message from the person; (2) printing a message from the person; (3) moving a message from the person from a first folder to a second folder; and (4) leaving a message from the person open for a predetermined period of time.

Instead, the Office Action relies upon *Harms*.

Harms, however, fails to cure the deficiencies of *Friskel*. The Office Action asserts, on page 5, that "*Harms et al.* teaches [that] the method automatically adds all contacts found in the inbox to the contact list, wherein the sender of the received messages that were open for a predetermined time and saved in an inbox will be added automatically to a contact list, (*Harms et al.*, Paragraph 45)." This is incorrect.

Paragraph 45 of *Harms* recites that "the method [of *Harms*] automatically adds all contacts found in the Inbox to the contact list that are not already there." (Emphasis

added). Nothing in this section, or any other section of *Harms*, discloses or suggests that the received messages were open for a predetermined time or saved by the user, as asserted in the Office Action.

Additionally, irrespective of the assertions in the Office Action, *Harms* still fails to disclose or suggest the aforementioned subject matter of claim 1. Claim 1 recites "determining . . . that a person is known to the user **based . . . on one or more actions performed by the user.**" (Emphasis added). In contrast, *Harms* adds contacts to a list based on the location of messages in the inbox, instead of based on actions performed by a user. That is, even if some of the messages were opened for a predetermined time or saved by a user, *Harms* **does not** base its addition of contacts on **the actions** allegedly performed by the user of *Harms*. Instead, as noted above, according to *Harms*, **all** contacts found in the Inbox are simply added to the contact list.

In view of the foregoing, there are significant differences between the cited art and independent claim 1 that the Office Action fails to address. Accordingly, no *prima facie* case of obviousness exists with respect to claim 1, and the rejection for claim 1 should be withdrawn.

Independent claims 23, 45, 50, and 53, while different in scope from claim 1 and each other, distinguish over the cited art for at least similar reasons to that presented above for claim 1. Claims 7-10, 12, 12, 13, 17-22, 24-30, 35, 39-44, 47, 49, 51, 52, 54, and 55 depend from one of the allowable independent claims and, therefore, distinguish over the prior art of record in view of claims, and further in view of the additional features recited in each of these claims.

Accordingly, the rejections based on *Friskel* and *Harms* should be withdrawn and the pending claims allowed.

II. Rejection under 35 U.S.C. § 103(a) based on *Friskel*, *Harms*, and *Koch*

Applicant respectfully traverses the rejection of claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Friskel* in view *Harms* in further view of *Koch*. A *prima facie* case of obviousness does not exist with respect to Applicant's claims.

Claim 11 depends from independent claim 1 and, therefore, should be allowed. As discussed above, combinations of *Friskel* and *Harms* fail to disclose each and every feature of claim 1. Similarly, *Koch* also fails to disclose or even suggest the aforementioned subject matter of claim 1, nor does the Examiner rely upon *Koch* to do so.

Accordingly, there are significant differences between the cited art and Applicant's claims that the Office Action fails to address. As such, a *prima facie* case of obviousness has not been established with respect to independent claim 1 or dependent claim 11, and the claims should be allowed.

III. Rejection under 35 U.S.C. § 103(a) based on *Friskel*, *Harms*, and *Caughey*

Applicant respectfully traverses the rejection of claim 14 under 35 U.S.C. § 103(a) as being unpatentable over *Friskel* in view *Harms* in further view of *Caughey*. No *prima facie* case of obviousness exists with respect to claim 14.

Claim 14 depends from independent claim 1 and, therefore, should be allowed.

As discussed above, combinations of *Friskel* and *Harms* fail to disclose each and every feature of claim 1. Similarly, *Chaghey* also fails to disclose or even suggest the

forementioned subject matter of claim 1, nor does the Examiner rely upon *Chaughey* to do so.

Accordingly, there are significant differences between the cited art and Applicant's claims that the Office Action fails to address. As such, a *prima facie* case of obviousness has not been established with respect to independent claim 1 or dependent claim 14, and the claims should be allowed.

CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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